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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,266	12/07/2001	Jeffrey D. Marsh	MARJ 8207US	1188

1688 7590 10/28/2004

POLSTER, LIEDER, WOODRUFF & LUCCHESI  
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EXAMINER

MACKEY, PATRICK HEWEY

ART UNIT PAPER NUMBER

3651

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/020,266

Applicant(s)

MARSH, JEFFREY D.

Examiner

Patrick H. Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-14, 18-25, 27, 29-34 and 36-42 is/are rejected.
- 7) ☒ Claim(s) 15-17, 26, 28, 35, 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 030502;070802;0419.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. This is a continuation in part of the U. S. Patent Application No. 09/793,671, filed February 26, 2001 (now U.S. Patent 6,443,682) which is a continuation of U. S. Patent Application No. 09/301,918, filed April 29, 1999 (now U. S. Patent 6,193,458), and claims the benefit co-pending U.S. Provisional Patent Application No. 60/254,106, filed December 8, 2000, and U. S. Provisional Patent Application No. 60/281,524 filed April 4, 2001.

### ***Claim Objections***

2. Claims 42 and 43 are objected to because they appear to duplicate claims 1 and 2.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "said second book" in line 6. There is insufficient antecedent basis for this limitation in the claim. Claim 31 recites the limitation "said second text page printer". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 5, 7-10, 13-14, 18-24, 36-39, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Dim et al. Dim discloses a device for printing and binding a perfect bound book that includes a text page printer (see col. 3, line 62); a cover printer (see col. 4, line 2); a cover transfer conveyor (19); a carriage (114); an adhesive application station (25); and a binding station (31) with a clamp (159).

7. Claims 1, 5-8, 13-14, 18, 25, 34, 36, 37, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaguchi et al. Yamaguchi discloses a device for printing and binding a perfect bound book that includes a text page printer (1a); a cover printer (1b); a cover transfer conveyor (60); a carriage (31,32); a milling station (43); an adhesive application station (54); and a binding station (63) with a clamp (61, 62).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 5, 7-14, 18-24, and 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gayoso in view of Dim et al. Gayoso discloses a device for printing and perfect binding books that includes a computer control system (110); a text printer (122); a cover

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printer (132); and a trimmer (144). Gayoso discloses all the limitations of the claims, but it does not disclose a cover transfer conveyor; a carriage; an adhesive application station; and a binding station with a clamp. However, Dim et al. discloses a similar device that includes a cover transfer conveyor (19); a carriage (114); an adhesive application station (25); and a binding station (31) with a clamp (159) for the purpose of conveying a cover and book block to a binding station for binding. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Gayoso by utilizing a cover transfer conveyor; a carriage; an adhesive application station; and a binding station with a clamp, as disclosed by Dim, for the purpose of conveying a cover and book block to a binding station for binding.

#### ***Allowable Subject Matter***

10. Claim 4 is allowed.

11. Claims 15-17, 26, 28, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

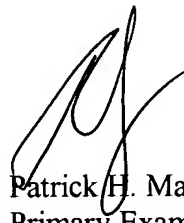
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (703) 308-0630.

The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick H. Mackey  
Primary Examiner  
Art Unit 3651

October 25, 2004